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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/724,530	11/28/00	SIEGALL	C 9632-012

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PENNIE AND EDMONDS
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NEW YORK NY 10036-2711

EXAMINER

CANELLA, K

ART UNIT PAPER NUMBER

1642

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DATE MAILED: 03/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/724,530

Applicant(s)
Slegall et al

Examiner
Karen Canella

Group Art Unit
1642



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 days month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-37 _____ is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-37 _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, 21-25, 34 and 36, drawn to a protein or antibody which binds CD40 and pharmaceutical compositions thereof, classified in class 514, subclass 2 and class 424, subclass 130.1.
 - II. Claims 10-20, and 35 in part, drawn to isolated nucleic acids and recombinant cells thereof and methods for producing recombinant protein, classified in class 536, subclass 23.5 and class 435, subclasses 69.1, 325 and 326. Claim 35 will be examined with this group to the extent that it read on an isolated cell.
 - III. Claims 26, 27, 37 and 32 and 33 in part, drawn to methods for the treatment or prevention of cancer comprising the administration of the proteins or antibodies of Group I, classified in class 530, subclasses 300, 350 and 387.1. Claims 32 and 33 will be examined with this group to the extent that they read on methods of treating or preventing cancer.
 - IV. Claims 28-31 and 32 and 33 in part, drawn to methods for activating or augmenting the immune system and methods for the treatment or prevention of an immune disorder comprising the administration of the proteins or antibodies of Group I, classified in class 530, subclasses 300, 350, 387.1. Claims 32 and 33 will be examined with this group to the extent that they read on methods of activating or augmenting the immune system and methods for the treatment or prevention of an immune disorder.
 - V. Claim 35 in part, drawn to a transgenic non-human animal, classified in class 800, subclass 8.
 - VI. Claim 35 in part, drawn to a transgenic plant, classified in class 435, subclass 419.

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2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I, II, V and VI are structurally and functionally different products which are made by different methods and have different uses. The examination of all groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

The methods of Groups III and IV differ in the method objectives, method steps and parameters and in the reagents used.

Inventions I and III are related as product and process of use. Inventions I and IV are also related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein or antibody of Group I can be used in an in vitro diagnostic assay.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because the searches required for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

3. Because of the complexity of the claims, telephonic restriction was not attempted.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

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named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Karen A. Canella, Ph.D.

Patent Examiner, Group 1642

March 12, 2001

